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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,587	10/31/2003	T. Scott Kennedy	RCX-022.01	1881
25181	7590	05/29/2008		
FOLEY HOAG, LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BLVD BOSTON, MA 02110			EXAMINER PALO, FRANCIS T	
			ART UNIT 3644	PAPER NUMBER
			MAIL DATE 05/29/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,587

Applicant(s)

KENNEDY, T. SCOTT

Examiner

Francis T. Palo

Art Unit

3644

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's arguments filed 4/15/08 have been fully considered but they are not persuasive.

The examiner is reminded that when determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious; and that the examiner has not shown how any reference or combination of references suggests that features selected from them should be combined in the manner that applicant discovered.

Applicant is respectfully reminded that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness, and in view of the guidance provided by the Supreme Court in KSR, an examiner must continue to articulate a reason or rationale to support an obviousness rejection, and when formulating an obviousness rejection, an examiner should expect that a person of ordinary skill in the art will exercise ordinary creativity, common sense and logic. The examiner submits that the guidelines discussed above properly support the obviousness rejections made in the prior office action.

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Applicant further asserts that Smak '014 does not teach a tray wherein each cavity is substantially *symmetrically open-ended at both ends*, and the examiner has noted that the limitation "substantially" as previously relied upon in the claim, is not specific enough to distinguish between the hexagonal-shaped open ends of Smak '014, or more specifically that the ribs of Smak '014 extend further into the base of the cavity rather than the top of the cavity.

By amendment applicant has removed said limitation and incorporated a number of features recited in the now cancelled dependent claims; Applicant's arguments have been considered but are now considered as moot in view of the new ground(s) of rejection, and the examiner upon further consideration, submits a new ground(s) of rejection as follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 8 and 9 are rejected under 35 U.S.C. 103(a),

as being unpatentable over **Otwell** (US 1,993,620) 1935

and **Pullman** (5,060,418) 1991, in view of **Keskilohko** (US Des. 504,530) 1998.

Regarding amended **claim-1**:

The examiner has maintained that trays comprising a plurality of non-tapered cavities symmetrically open-ended at both ends are old in the art of plant production, and in their construction have evolved from paper or other like flexible material to "substantially rigid material" as claimed; **Otwell '620** and **Pullman '418** fairly well teach that contention. Neither Otwell nor Pullman however teach ribs protruding into the cavities as claimed.

Keskilohko '530 like many others teach a tray for the growing of seedlings having a plurality of rectangular ribs protruding into each cavity, positioned and extending as claimed.

It has been held that it is not required that the prior art disclose or suggest the properties 'newly-discovered' by an applicant in order for there to be a prima facie case of obviousness (see *In re Dillon*). Moreover, as long as some motivation or suggestion to combine the reference is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor (see *In re Beattie*). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art (see *In re Keller*).

In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided the tray of Pullman '418, specifically the cells of Pullman, with ribs as taught by Keskilohko '530 for the well known advantages of that feature, such as strengthening means or soil plug retention means, as where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly, applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

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Accordingly, since the applicant has submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Regarding claims 3 and 4:

The discussion above regarding claim-1 is relied upon.

The square (polygonal) non-tapered cavities of Pullman are of uniform size and shape as claimed.

Regarding claims 6, 8 and 9:

The discussion above regarding claim-1 is relied upon.

The ribs of Pullman as modified by Keskilohko are uniform in size, evenly spaced and positioned as claimed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

van Wingerden '188 and Timmis '588 teach variations on the miniplug tray.

Saarinen '048 and Panth '000 teach ribs in plant trays.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on 571-272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Francis T. Palo/
Primary Examiner
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